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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD M. HOUSEL

Appeal No. 2004-2064
Application No. 09/692,645

ON BRIEF

MAILED

JUN 15 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before RUGGIERO, DIXON, and MACDONALD, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1, 3-5, 7-25, and 27-30. Claims 2, 6, and 26 are indicated by the Examiner to be allowable subject to being rewritten in independent form.

The claimed invention relates to a method of generating setup instructions for a printing system having a finishing device connected thereto. A sheet of setup instructions is

printed and carried to the finishing device to be setup permitting the operator to refer to the printed instructions during finishing device setup. One or more print jobs are automatically placed on hold during finishing device setup until the setup operator finishes setup and releases the held print jobs. According to Appellant (specification, page 8), the printed instruction sheet permits clearer and more extensive instructions to be communicated to a setup operator than is possible using a printer user interface.

Representative claim 1 is reproduced as follows:

1. A method of performing setup operations on a finishing device connected to an electrophotographic printer, the printer having a printer user interface, comprising the steps of:

a) entering a print job into the printer, the print job including setup instructions for at least one finishing device written as an operator message;

b) automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job;

c) automatically placing all pending print jobs on hold;

d) performing the setup operations listed on the printed instruction sheet; and

e) entering a release code to thereby release the print job from hold and allow the printer to complete the print job.

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The Examiner relies on the following prior art:

Ikegaya et al. (Ikegaya)	5,263,129	Nov. 16, 1993
Matysek et al. (Matysek)	5,442,732	Aug. 15, 1995
Chen et al. (Chen)	5,822,506	Oct. 13, 1998
Yamada	5,798,738	Aug. 25, 1998
Olarig	5,878,237	Mar. 02, 1999

Claims 1, 3-5, 7-25, and 27-30 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Chen in view of Ikegaya with respect to claims 9, 13, 17, 21, 25, 29, and 30, adds Matysek to the basic combination with respect to claims 1 and 5, adds Yamada to the basic combination with respect to claims 11, 12, 15, 16, 19, 20, 23, 24, 27, and 28, and adds Olarig to the basic combination with respect to claims 10, 14, 18, and 22. With respect to claims 3, 4, 7, and 8, Yamada is added to the combination of Chen, Ikegaya, and Matysek.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

¹ The Appeal Brief was filed December 18, 2002 (Paper No. 10). In response to the Examiner's Answer dated March 11, 2003 (Paper No. 12), a Reply Brief was filed May 16, 2003 (Paper No. 13, which was acknowledged and entered by the Examiner as indicated in the communication dated January 29, 2004 (Paper No. 14).

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in appealed claims 1, 3-5, 7-25, and 27-30. Accordingly, we affirm.

At the outset, we note that Appellant indicates (Brief, page 6) that the appealed claims stand or fall together as a group. Consistent with this indication, Appellant's arguments in the Briefs are directed solely to features which are set forth in independent claim 1. Accordingly, we will select independent claim 1 as the representative claim for all the claims on appeal, and claims 3-5, 7-25, and 27-30 will stand or fall with claim 1. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed.

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Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed waived (see 37 CFR § 41.37(c)(1)(vii)).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to representative independent claim 1, Appellant's arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not

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taught or suggested by the applied prior art references. After reviewing the applied prior art references in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. It is our view that Appellant's arguments unpersuasively focus on the individual differences between the limitations of representative independent claim 1 and each of the applied references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 1096-97, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellant asserts (Brief, pages 9-12) a list of features which are allegedly missing from Ikegaya, we find that these features are all present in Chen. For example, as pointed out by the Examiner (Answer, page 19), the generation of instructions for an operator to setup a finishing device prior to the completion of a particular print job is provided by the disclosure of Chen.

Further, contrary to Appellant's contention (Reply Brief, page 3), it is apparent to us from the line of reasoning expressed in the Answer that the Examiner is not suggesting the bodily incorporation of Ikegaya's instruction sheet printing feature into the printing system disclosed by Chen. Rather, as asserted by the Examiner (Answer, page 19), it is Ikegaya's teaching of printing setup instructions on an easily carried sheet of paper that is relied on as a rationale for the proposed combination. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of [those] references would have suggested to those of ordinary skill in the art." Keller, 642 F.2d at 425, 208 USPQ at 881. See also In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) and In re Nievelt, 482 F.2d 965, 967-68, 179 USPQ 224, 226 (CCPA 1973).

We further find, Appellant's arguments to the contrary notwithstanding, clear motivation for the skilled artisan to look to the teachings of Ikegaya for modification of the system of Chen. While Appellant contends (Reply Brief, page 3) that the Examiner has not shown where the advantages of the proposed combination of Chen and Ikegaya are disclosed in the references,

we find clear evidence to the contrary. Although Appellant asserts that the post processing operations in Chen are "under control of a processor and without operator setup" (Brief, page 16), it is clear from the disclosure of Chen (Figure 2, steps 40 and 44 and column 4, lines 24-32) that an operator is utilized to carry out post processing instructions generated by Chen's printing system processor.

Further, we agree with the Examiner (Answer, page 20) that Ikegaya provides an explicit disclosure of the advantages (column 1, lines 45-50 and column 8, lines 15-20) of utilizing a printed sheet of setup instructions to avoid the need for an operator to continually refer to a display screen or an instruction manual. In our view, for the reasons articulated by the Examiner, we find that, since Chen is silent about the particular manner in which the disclosed setup instructions are provided to a setup operator, one of ordinary skill would have logically consulted the teachings of the Ikegaya reference to improve the efficiency of setup operations in Chen. As the Federal Circuit recently stated, " . . . this court has consistently stated that a court or examiner may find a motivation to combine prior art references

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in the nature of the problem to be solved." See Ruiz v. A.B. Chance co., 357 F.3d 1270, 1274, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). See also Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), citing In re Rinehart, 531 F.2d. 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness).

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of representative claim 1, as well as claims 3-5, 7-25, and 27-30 which fall with claim 1, is sustained.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 3-5, 7-25, and 27-30 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

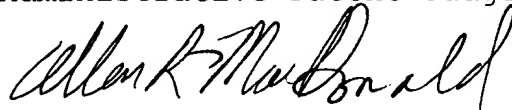
AFFIRMED



JOSEPH F. RUGGIERO
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge



ALLEN R. MACDONALD
Administrative Patent Judge

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